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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/622,517	08/17/2000	Mitsuru Tanabe	KOIK-Q9495	8570

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

BAYAT, BRADLEY B

ART UNIT PAPER NUMBER

3621

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/622,517

Applicant(s)

TANABE ET AL.

Examiner

Bradley Bayat

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-8 and 10-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-8 and 10-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

Applicant has amended claims 2, 3, and 12 and canceled claim 1 in the amendment filed on 4 February 2004. Thus, claims 2-8 and 10-13 are presented again for examination on the merits.

Response to Arguments

Applicant's arguments filed February 4, 2004 have been fully considered but they are not persuasive.

Applicant acknowledges that the cited reference, Morito et al. ('956) "disclose that recording of digital data is prevented if the time difference between the transmission time, which is embedded in the digital data, and the current time is greater than a threshold value (applicant's response page 6)." However, applicant argues that Morito does not disclose how content is prohibited from duplication when a predetermined amount of time has not passed yet the content was already duplicated (response pg. 6). The examiner respectfully disagrees.

Applicant's argument regarding prohibition of already duplicated data regardless of passage of time is well known in the art and described in the background of the cited reference. The examiner refers applicant to Morito's description of copy-once signals and various well-known methods of copy prevention (see columns 1 and 2, background of the invention).

Applicant further distinguishes Morito from the claimed invention, arguing that the "temporal data is not embedded into the content, but rather stored in a database (applicant's response pg. 6)."

As applicant is well aware and is well known in the art, a database is merely a file that contains two or more records with field for carrying out certain operations, i.e., searching. Therefore, applicant's point is rather insignificant because regardless of the location, the same function is performed. However, Morito in fact addresses this option in an alternative embodiment of his invention (column 7, lines 20-35). Morito goes on to further describe that the temporal data, specifically "the predetermined threshold value of time difference, above which recording is prevented, can be stored in a ROM memory interfaced to a microprocessor (column 7, lines 43-54)."

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-8 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morito et al., U.S. Patent No. 6,310,956 B1 in view of Endoh, U.S. Patent No. 4,965,680.

As per claims 2-8 and 10-13, Morito et al. discloses a copy protection apparatus and method for use in digital data recorder, which includes embedding transmission time information into a digital stream by digital watermarking and comparing the transmission time with the current time. If the time difference is greater than a threshold value it is presumed that the recording is an attempted unauthorized recording such as from a pre-recorded copy, and further recording is prevented (see abstract and summary of the invention). Morito et al. discloses an

embedding module that obtains the copy control signal to be embedded from the “copy control information database” and embeds it into the data using for example, a digital watermarking technique and subsequently sends the data to the transmission module (fig 1, columns 1-4).

Morito et al. does not teach the use of an International Standard Recording Code (ISRC), an identification tool used in electronic music distribution and rights administration. Endoh teaches the use of ISRC and other identifying information, i.e., table of contents for use in recording (see column 13-32). Endoh is evidence that one of ordinary skill in the art would recognize the benefit of utilizing the ISRC coding mechanism. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention utilize the ISRC identification system made available primarily for such a purpose, as per teachings of Endoh et al.

As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. TMEP 2106.

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as

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potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

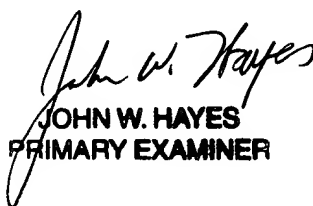
- Patent No. 5,884,072 to Rasmussen.
- Patent No. 6,044,197 to Smith et al.
- Patent No. 5,963,382 to Abe.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Bayat whose telephone number is 703-305-8548. The examiner can normally be reached on Tuesday-Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bbb


JOHN W. HAYES
PRIMARY EXAMINER